

REMARKS

The Office Action dated February 16, 2010 has been received. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

Obviousness Rejections of Claims 49-96

At page 2 of the Office Action, claims 49-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Date (U.S. Patent No. 5,959,677) in view of Guetz (U.S. Patent No. 6,091,777) and further in view of Taunton (U.S. Patent No. 6,591,013). At page 5 of the Office Action, claims 59-96 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Date in view of Guetz in further view of Taunton and in further view of Putzolu (U.S. Patent No. 6,584,509). These rejections are respectfully traversed.

In *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727, 1740-41, 82 U.S.P.Q.2d 1385 (2007), the Supreme Court stated “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent *reason* to combine the known elements *in the fashion claimed by the patent at issue*. To facilitate review, this analysis should be made explicit.” (emphasis added). Thus, under *KSR*, obviousness can only be established if it can be established that 1) all of the elements of a claim were known, and that 2) there was a *reason* to combine those elements *in the fashion claimed*. See also *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed*.” (emphasis added)).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *MPEP* § 2141.02 (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)(emphasis in original). Moreover, a prior art reference must be considered in its entirety, i.e., as a whole, including

portions that would lead away from the claimed invention. *Id.* (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984))(emphasis in original).

Independent claim 49 recites the features of “selecting, at a media server, a first set of one of more multimedia channels of a plurality of multimedia channels of a first data stream responsive to determining a transmission of the first data stream is not expected to meet a predetermined criteria, the predetermined criteria comprising at least one of a real-time transmission or a transmission within a predetermined bandwidth *and the plurality of multimedia channels including one or more multimedia channels not selected for the first set;*” “compressing, at the media server, each multimedia channel of the first set to generate a second set of one or more multimedia channels;” and “generating, at the media server, a second data stream comprising the second set of multimedia channels and the one ore more multimedia channels not selected for the first set.” Independent claims 65 and 81 recite similar combinations of features. The Office relies on Date as disclosing the majority of the features of claims 1, 65, and 81, with the exception of “the plurality of multimedia channels including one or more multimedia channels not selected for the first set.” Acknowledging that Date does not disclose this feature, and the Office turns to Taunton. *Office Action*, p. 3. In particular, the Office asserts that “Taunton teaches that prior art encoding devices suffer from a decrease in the degree of compression (Taunton: column 1, lines 31-35)” and “to help alleviate this problem, Taunton discloses ‘the plurality of channels including one or more channels not selected for the first set’ (Taunton: column 1, lines 46-63).” *Id.* The Office then asserts that it would have been obvious “to take the apparatus disclosed by Date, add the determination [of whether a transmission of the second stream is expected to meet the criteria] taught by Guetz, and add the channel selection taught by Taunton in order to obtain a system that helps reduce the cost of encoding systems.” *Id.*, pp. 3-4. The Applicant respectfully disagrees for at least the reasons below.

Date is directed to encoding/compressing a plurality of video/audio signals being transmitted. Taunton, on the other hand, is directed to decoding/decompressing multiple “image channels.” To wit, the relied-upon passage of Taunton at col. 1, lines 45-63 outlines a process whereby a selected image channel is *decoded* and another non-selected image channel also is *decoded* in parallel. As taught by Taunton, the intent of this parallel decoding of the non-

selected image channel is to allow the decoding system to quickly switch to the non-selected image channel in the event that the non-selected image channel later becomes a selected image channel. *See, e.g., Taunton*, col. 2, lines 8-16. As Date is directed to the encoding side and Taunton is directed to the decoding side, the techniques of Date and Taunton are directed at opposite ends of a video system. The operation at the decoding side would not impact the operation of the encoding side in this instance, so the actual result of the combination of Date and Taunton would be a video processing system whereby each and every image channel is encoded at the transmitting side of the system (as taught by Date) and whereby the receiving side of the system decodes in parallel a selected one of the image channels and a non-selected one of the image channels so as to facilitate a rapid switch to the non-selected image channel (as taught by Taunton). This result does not disclose or render obvious the particular combinations of features recited by claims 49, 65, or 81.

Moreover, not only does the actual result of a combination of Date and Taunton (and Guetz and Putzolu) fail to disclose or render obvious the features of claims 49, 65, or 81, it would not have been obvious to deviate from the actual result of a combination of Date and Taunton as required by the Office's proposed combination. As described in previous responses, Date discloses that each and every "video/audio signal" is "compressed" when the predetermined criteria is not met and thus there are no "video/audio signals" not selected for compression when the predetermined criteria is not met in the system of Date. Accordingly, the Office's proposed modification of Date such that one or more video/audio signals remain uncompressed is contrary to the explicit teachings of Date. As such, the Office has the burden of making a *prima facie* case that one of ordinary skill in the art would have needed a reason to deviate from the teachings of Date so as to not select each and every video/audio signal for compression. It is respectfully submitted that the Office has not done so.

As an initial issue, the Office has not shown how one of ordinary skill in the art would have generally understood a parallel decoding process at the decoding side of a video system as disclosing a selection process for implementation at an encoding side of a video system. Moreover, when considering the particular aspects of Taunton, it would have been understood that Taunton teaches processing of a "non-selected" channel for the purpose of enabling a faster switch to the non-selected channel for decoding and display in the event that the non-selected

channel subsequently is selected. This purpose has no significance at the encoding system taught by Date and thus one of ordinary skill in the art would not have had a reason to turn to the particular decoding technique of Taunton when considering ways to modify the encoding technique of Date.

In addressing the motivation for the combination of Date and Taunton, the Office points to Guetz as teaching that “there is a need in the art for an improved cost effective coding system.” As best understood from this statement, it appears that the Office is contending that the modification of Date in view of Taunton would be motivated by the desire for “an improved cost effective coding system.” However, the Office has not provided any evidence or rationale supporting an assertion that the proposed combination of Date and Taunton would result in an “improved cost effective coding system.” As noted above, the technique of Taunton is intended for improved switching between *decoded* channels and it is not clear how a decoding technique improves the encoding systems disclosed by Date and Guetz in any manner. Thus, one of ordinary skill in the art, considering Date and Taunton in their entireties, including the purposes of the disclosed techniques and the motivation allegedly provided by Guetz, would not have had a reason to combine Date and Taunton in the manner proposed by the Office. Absent a reason, it would not have been obvious to combine Date and Taunton as proposed by the Office.

As described above, the Office has not provided a sufficient reason for one of ordinary skill in the art to have combined Date and Taunton and thus the Office has not established that the proposed combinations of Date, Taunton, Guetz, and Putzolu would have been obvious. As also described above, even if it would have been obvious to combine Date, Taunton, Guetz, and Putzolu, the actual result of this combination would not disclose each and every feature recited by claims 49, 65, or 81. Rather, it would have taken additional modification to, and deviation from, the teachings of Date and Taunton to arrive at the particular combinations of features recited by claim 49, 65, and 81, support for which is not found in the disclosures of Date, Taunton, Guetz, or Putzolu, nor in the knowledge of one of ordinary skill in the art. Claims 49, 65, and 81 therefore are allowable over Date, Taunton, Guetz, and Putzolu, as are the claims depending from claims 449, 65, and 81 at least by virtue of this dependency. Moreover, these dependent claims recite additional novel and non-obvious features.

In view of the foregoing, reconsideration and withdrawal of the obviousness rejections is respectfully requested.

Conclusion

The Applicant respectfully submits that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-1835.

Respectfully submitted,

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Date